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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO	
10/799,389	03/12/2004	Mitsunori Ono	3211.1013-001	1892	
21005	7590 09/01/2006		EXAM	INER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD			навте, к	HABTE, KAHSAY	
P.O. BOX 913	-		ART UNIT	PAPER NUMBER	
CONCORD,	MA 01742-9133		1624		

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

,		Application No.	Applicant(s)			
Office Action Summary		10/799,389	ONO ET AL.			
		Examiner	Art Unit			
		Kahsay Habte	1624			
	The MAILING DATE of this communication app					
Period fo	or Reply					
WHIC - Exter after - If NC - Failu Any	ORTENED STATUTORY PERIOD FOR REPLICHEVER IS LONGER, FROM THE MAILING DIPLICATION OF THE MAILING DIPLIC	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be timwill apply and will expire SIX (6) MONTHS from a cause the application to become ABANDONEI	N. nely filed the mailing date of this communication. D' (35 U.S.C. § 133).			
Status						
1)⊠	Responsive to communication(s) filed on 24 J	<u>uly 2006</u> .				
2a)□	This action is FINAL . 2b)⊠ This action is non-final.					
3)[Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
	closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.					
Dispositi	on of Claims					
4)⊠ Claim(s) <u>1-28</u> is/are pending in the application.						
• —	4a) Of the above claim(s) <u>15-24</u> is/are withdrawn from consideration.					
5)	5) Claim(s) is/are allowed.					
6)⊠	☑ Claim(s) <u>1-14 and 25-28</u> is/are rejected.					
	Claim(s) is/are objected to.					
8)□	Claim(s) are subject to restriction and/o	or election requirement.				
Applicati	on Papers					
9)[The specification is objected to by the Examine	er. "				
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).						
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.						
Priority L	ınder 35 U.S.C. § 119					
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:						
	1. Certified copies of the priority documents have been received.					
	2. Certified copies of the priority documents have been received in Application No					
3. Copies of the certified copies of the priority documents have been received in this National Stage						
application from the International Bureau (PCT Rule 17.2(a)).						
* See the attached detailed Office action for a list of the certified copies not received.						
Attachmen	t(s)					
1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)						
2) Notic	e of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Da				
	mation Disclosure Statement(s) (PTO-1449 or PTO/SB/08) r No(s)/Mail Date <u>12/8/04&11/18/04</u> .	6) Other:	atont Application (FTO-192)			

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DETAILED ACTION

1. Claims 1-28 are pending in this application.

Election/Restriction

2. Applicant's election with traverse of Group II drawn to compounds of Formula (1) where $V_1 = V_2 = V_3 = C$ and $V_4 = N$ in the reply filed on 7/24/2006 is acknowledged. The traversal is on the ground that "The examiner restricted Claims 15 and 16 and classified as Grou VII as being drawn to complex compositions. However, claims 15 and 16 depend from independent Claim 14. Thus, Claims 15 and 16 are patentable once one of ingredients, e.g. at least one compound according to claims 1 ahs also been shown to be novel and nonobvious. MPEP 806.05 (C) states....The examiner did not show any evidence that claims 15 and 16 are patentable without the details of Claim 14...there should be no additional search burden on the examiner ". The examiner disagrees with applicants. The compounds and simple composition of Group II are different from Group VII (complex composition), because of the additional ingredient present in the complex composition. Note that there is a possibility of synergistic interaction, which is usually the purpose of the complex composition in the first place. Furthermore coexamination Group VIII would require search of subclasses unnecessary for the examination of the elected claims. The examiner has to search for the additional ingredient in class 514 or in other commercial search databases. Therefore, coexamination of the additional invention would require a serious additional burden of search.

The requirement is still deemed proper and is therefore made FINAL.

3. The claims are drawn to multiple inventions for reasons set forth in the restriction requirement. The claims are examined only to the extent that they read on the elected invention. Cancellation of the non-elected subject matter is recommended in response to this Office Action.

Information Disclosure Statement

4. Applicant's Information Disclosure Statement, filed on 12/8/2004 and 11/18/2004 has been acknowledged. Please refer to Applicant's copies of the 1449 submitted herewith.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 and 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. Claim 1 and claims dependent thereon are rejected because the term "substituted" is indefinite. In the absence of the specific moieties intended to effectuate

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modification by the "substitution" or attachment to the chemical core claimed, the term "substituted" renders the claims in which it appears indefinite in all occurrences wherein applicants fails to articulate by chemical name, structural formula or sufficiently distinct functional language, the particular moieties applicants regards as those which will facilitate substitution, requisite to identifying the composition of matter claimed.

- b. In claim 1, the phrase "Ring A substituent" is indefinite. What substituent? What is covered and what is not? Applicants have to recite Ring A substituents to overcome this rejection.
- c. Regarding claim 4, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
- d. In claim 13, the phrase "Compounds (I-1) through (I-14)" is indefinite. What compounds? If applicants intend compounds that are disclosed in the specification, they have to recite the compounds in the claims.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kahsay Habte / / Primary Examiner Art Unit 1624

KH August 30, 2006